



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,817	12/22/2000	Hiroshi Uchikoga	5664-00100	3570

7590 07/22/2005

Eric B. Meyertons
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

EXAMINER

USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,817

Applicant(s)

UCHIKOGA, HIROSHI

Examiner

Joseph G. Ustaris

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/28/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 28 April 2005 in application 09/748,817. Claims 1, 4-11, and 14-25 are pending. Claims 1, 4-11, and 14-22 are amended. Claims 23-25 are new.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 28 April 2005 was filed after the mailing date of the Non-final rejection on 26 January 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 10, 11, 14, 16, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Mages et al. (US006035329A).

Regarding claim 1, Mages et al. (Mages) discloses a "multimedia information playback apparatus" (See Figs. 1 and 2). The system comprises a DVD player or "first input means" for receiving multimedia information including video data and audio data distributed from a DVD disk or "first distribution source", wherein the DVD disk is a storage device for storing multimedia information, and the DVD disk is on the "user side" (See Figs. 1 and 2, DVD player 12 and DVD disk 10; column 3 lines 15-42). The system also has data ports or "second input means" for receiving enabling/critical data or "control information" distributed from a second distribution source, wherein the second distribution source is an Internet server/cable-TV provider or "network server" for distributing the control information (See Fig. 1, data ports 18; column 4 lines 20-41). The DVD player also serves the function as the "playback means" for playing back the multimedia information received by the first input means on the basis of the control information received by the second input means, and wherein the playback means plays back the multimedia information which is distributed from the storage device and received by the first input means, on the basis of the control information which is distributed from the network server and received by the second input means (See Fig. 1; column 3 lines 15-60 and column 4 lines 20-41).

Regarding claim 4, the DVD player has a "first playback mode", where if the DVD disk is not a non-Hyper-DVD, the DVD player plays back the multimedia information from the DVD disk or "storage device" on the basis of the parental rating controls or "control information" that is also distributed by the DVD disk and received by the second input means (See Fig. 1 ; column 1 line 61 – column 2 line 13). The DVD player also

Art Unit: 2617

has a "second playback mode", where if the DVD disk is a Hyper-DVD, the DVD player plays back the multimedia information from the DVD disk on the basis of the enabling/critical data or "control information" which is distributed from the network server and received by the second input means (See Fig. 1; column 3 lines 15-60 and column 4 lines 20-41). The system further comprises a switching means for switching a playback mode to either one of the "first and second playback modes" (See Fig. 1, data switch 26).

Regarding claim 6, the CPU (See Fig. 1, CPU 22) serves the function of the "first navigator unit" wherein it "reads out the control information" from the DVD disk, "analyzes the control information", and controls the DVD player and data switch to "read the multimedia information in the storage device in accordance with an analysis result" when playing a non-Hyper-DVD or "first playback mode" (See Fig. 1; column 3 lines 15-60 and column 4 lines 20-41). Furthermore, the CPU also serves the function of the "second navigator unit" wherein it reads a Hyper-DVD or "second playback mode" on the "basis of the control information distributed from the network server in the second playback mode" (See Fig. 1; column 3 lines 15-60 and column 4 lines 20-41).

Regarding claim 10, the control information contains a program for checking parental rating controls or "user operation contents", and when user operation is detected during playback of the multimedia information, the DVD player runs the parental rating controls, and plays back the multimedia information corresponding to the parental rating controls or "user operation contents" (See column 1 line 61 – column 2 line 13).

Claim 11 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 14 contains the limitations of claims 4 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 16 contains the limitations of claims 6 and 14 and is analyzed as previously discussed with respect to those claims.

Claim 20 contains the limitations of claims 10 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 21 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim.

Claim 22 contains the limitations of claims 11 and is analyzed as previously discussed with respect to that claim.

Regarding claim 23, the first distribution source is a DVD-ROM (See Fig. 1, DVD disk 10; column 3 lines 15-25).

Claim 24 contains the limitations of claims 11 and 23 and is analyzed as previously discussed with respect to those claims.

Claim 25 contains the limitations of claims 22 and 23 and is analyzed as previously discussed with respect to those claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2617

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. (US006035329A) in view of Kamo (US 20020057694A1).

Claim 5 contains the limitations of claim 4 and is analyzed as previously discussed with respect to that claim. Furthermore, as discussed in claim 4 the data switch is able to switch playback modes based on the DVD disk placed in the player by the user. However, Mages does not disclose authenticating the "network server".

Kamo discloses a source information controlling system for a server and a client. Kamo discloses a session control unit that is used to authenticate the server and client in order to establish a connection (See Fig. 3; paragraph 0098). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify DVD player and Internet server/cable-TV provider disclosed by Mages to include a session control unit to authenticate the Internet server/cable-TV provider, as taught by Kamo, in order to ensure that the DVD player connects with known and trusted servers.

Claim 15 contains the limitations of claims 5 and 14 and is analyzed as previously discussed with respect to those claims.

Claims 7, 9, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. (US006035329A) in view of Dan et al. (US005561637A).

Claim 7 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, the system generates "control information" that is used to allow play back of the "multimedia information" on the DVD player as discussed in claim 1 above. However, Mages does not disclose generating "group management information for managing a plurality of users having similar personal information as one group".

Dan et al. (Dan) discloses that the server is able to multicast to a group of clients. The server selects a client to be a leader for a group of clients watching the same video or "generates group management information for managing a plurality of users having similar personal information as one group" and proceed to transfer the same data to all the clients within the group (See column 2 line 61 – column 3 line 6). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Internet server/cable-TV provider disclosed by Mages to be able to group DVD players and generate "group management information for managing a plurality of users having similar personal information as one group", as taught by Dan, in order to increase the efficiency of the Internet server/cable-TV provider.

Regarding claim 9, Mages in view of Dan disclose that a video server utilizes and reserves channels or "plurality of channels" to transmit "multimedia information", wherein the terminal apparatus/cable box "plays back multimedia information of a channel" that has been reserved or "corresponding to the control information" (See Dan Fig. 1; column 2 lines 36-49).

Claim 17 contains the limitations of claim 7 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 19 contains the limitations of claim 9 and 11 and is analyzed as previously discussed with respect to those claims.

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. (US006035329A) in view of Brown et al. (US006732179B1).

Claim 8 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, the DVD player includes software that inherently allows a user to set/change parental rating controls or "change operation of the control information by a user (See Fig. 1; column 1 line 61 – column 2 lines 13). The DVD player is able to play back the multimedia information on the basis of the parental rating controls or "control information" changed in accordance with user operation. However, Mages does not disclose "determining whether to receive the change operation in accordance with personal information of the user".

Brown et al. (Brown) discloses a method and system for restricting access to user resources within a client, i.e. set top box (STB). Brown discloses that a user of a client logs in by entering a user's identity and a personal identification number (PIN) or "personal information of the user" in order to grant access to certain resources for the user or "determining whether to receive the change operation" (See column 7 lines 22-40). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the DVD player and cable box disclosed by

Mages to include a means to determine whether to allow users to enter change operations, using the "personal information of the user", as taught by Brown, in order to increase the security of the system thereby only allowing authorized users to change various settings.

Claim 18 contains the limitations of claims 8 and 11 and is analyzed as previously discussed with respect to those claims.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 4-11, and 14-22 and Emura have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues with respect to claims 7, 9, 17, and 19 that portions of the rejections appear to be set forth in facts within the personal knowledge of the examiner and cites MPEP 2144.03. However, the rejection made to claims 7, 9, 17, and 19 do not rely on an Official Notice or Common Knowledge. Furthermore, applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. It is unclear to what "portions of the aforementioned rejection" appears to be set forth in facts within personal knowledge of the examiner.

Dan discloses a method of managing a group of clients that are viewing the same video or "managing a plurality of users having similar personal information". When a request is made to the server, the server responds to the whole group of clients as one group. Dan uses this method to create a hybrid system that is more efficient than

Art Unit: 2617

other server system as disclosed by Dan (See Dan column 1 lines 28-40 and column 2 line 61 – column 3 line 6).

In response to applicant's argument with respect to claims 8 and 18 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brown discloses a STB that is able to restrict access to resources within the client or DVD player or STB based on the user's PIN or "personal information of the user". Brown offers this capability in order to ensure that only authorized and authenticated users are able to make changes to the client. Therefore adding the features disclosed by Brown in the system disclosed by Mages increases the security features (e.g. parental ratings control) of DVD player and cable box.

The examiner suggests that applicant consider adding more details in the independent claims about the control information (e.g. read control, various commands, and positional information) as supported by the specification on pages 7 and 10.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JGU
July 18, 2005



VIVEK SRIVASTAVA
PRIMARY EXAMINER